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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,372	09/26/2003	Reinhold Berkau	510.1085	8543

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EXAMINER

MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,372

Applicant(s)

BERKAU ET AL.

Examiner

Sanza L. McClendon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/2005 has been entered.

Response to Amendment

2. In response to the Amendment received on November 21, 2005, the examiner has carefully considered the amendments. The claim rejection under 35 U.S.C. § 112, 2nd paragraph for claim 11 has not been overcome by the amendment—see below.

Response to Arguments

3. Applicant's arguments filed 11/21/2005 have been fully considered but they are not persuasive. However, the rejection of claims 1-5 and 8 under 35 USC 102(b) or, in the alternative, under 35 USC 103(a) as being unpatentable over Walbridge has been withdrawn. The rejection of claims 1-5 and 8-10 under 35 USC 103(a) as being unpatentable over Zimmt in view of Walbridge has been withdrawn. The rejection of claims 1-3 and 5-11 under 35 USC 102(b) or, in the alternative, under 35 USC 103(a) as being unpatentable over Nakatani still stands.

Claim Rejections - 35 USC § 102/35 USC § 103

4. Claims 1-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakatani et al (US 4,916,019).

The German equivalent of this document is described in applicant's disclosure as prior art. Nakatani et al teaches cationically-depositable, epoxy-type resins (A) having a surface tension of 40 to 60 dynes/cm mixed with a non-ionic-type resin (B) having a surface tension from 25 to 45

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dynes/cm, wherein it is disclosed by Nakatani et al the combination of resins should have a surface tension difference of at least 5 dynes/cm, which directly converts to 5 mN/m. Nakatani et al teaches said composition can be prepared by dispersing and/or dissolving (A) and (B) in an aqueous medium as outlined in column 7, lines 1-15, wherein it is deemed that method (2) reads on the instant coating composition.

The non-ionic resins can be selected from those found in column 5-6, wherein (1) acrylic resins that may or may not have radiation curable groups (from the butadiene as a third component), (2) polyester resins, (3) mixtures of acrylic and polyester resins, and (4) non-ionic silicone resin, such as alkyd modified silicone resins, which appears to anticipate claims 5-6. Note, the examiner is determining the limitation "configured to be a future intended limitation, i.e., that the clear lacquer component in the coating composition as written is not configured to be crosslinked and hardened by UV-light curing. Using applicant's remarks received 9/26/2005 in response to the Final Office action of June 24, 2005, applicant states that the component is set-up or adapted to be crosslinked/hardened by UV-light. As written "is configured" is not a positive limitation, i.e., not necessarily done at the time of making the composition. This limitation as written implies that the component can be configured at a latter time, such as before curing but after mixing.

Nakatani et al teaches pigments can be added to the composition with either the (A) resin or the (B) resin—see column 7, lines 29-31. The coating compositions produce a heat cured multi-layer structures where the (A) component is predominately distributed in the lower layer portion in contact with the substrate giving corrosion resistance and the (B) component is predominately distributed in the upper portion layer providing excellent weatherability; wherein Nakatani et al teaches said separation is caused by the difference in surface tension.

While it is noted that Nakatani et al does not expressly teach the thickness of the separate layers, the examiner deems because the coating composition as taught by Nakatani et al reads on the instant composition, it should be able to function in the same ways, such as coating thickness' of the separate layers. Note claim 4 is included in the rejection since claim 2 is met by the reference, i.e., thermal curing. The inventions of claims 1-11 are deemed to be in the reference.

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Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanza L. McClendon

Examiner

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